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To:	**Examiner: Nasser Ahmad**
Company:	**U.S. Patent & Trademark Office**
Location:	Alexandria, VA
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Date:	June 20, 2005
Message Attached:	**Response**
File No.:	**58611US002**
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Patent
Case No.: 58611US002

32692
Customer Number

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	THIELE, JOHN L.		
Application No.:	10/676454	Group Art Unit:	1772
Filed:	October 1, 2003	Examiner:	Nasser Ahmad
Title:	DEBRIS REMOVAL TAPE AND METHOD OF USING SAME		

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☒ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

06-20-05
Date

Signed by: Susy Hendrickson

Dear Sir:

This is in response to the Office Action mailed April 5, 2005.

Election

Claims 1-44 are pending. Claims 1-44 were restricted under 35 USC § 121 as follows:

I. Claims 1-35 are said to be drawn to a tape, classified in Class 428, subclass 40.1;

II. Claims 36-44 are said to be drawn to a method of removing contaminants, classified in Class 134, subclass 4.

During a telephone conversation with Examiner Ahmad on March 31, 2005, a provisional election was made without traverse to elect Group I. Reconsideration and withdrawal of the restriction requirement is respectfully requested.

Applicant submits that Groups I and II claims are so interrelated that a search of one group of claims will reveal art to the other. Moreover, the classification of Groups I and II claims in different classes and subclasses is not sufficient grounds to require restriction.

Were restriction to be effected between the claims in Groups I and II, a separate examination of the claims in Groups I and II would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration would be necessary, the scope of analysis of novelty of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicant submits that for restriction to be effected between the claims in Groups I and II, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting two applications and maintaining two patents.

Applicant has elected Group I. Continued prosecution of this application is respectfully requested.

§ 103 Rejections

Claims 1-4, 9-13, 18-22, and 27-32 are rejected under 35 USC § 103(a) as being obvious over Aalbers (U.S. Pat. 6,865,765) in view of Pallone (U.S. Pat. 4,990,192). Additionally, claims 5-8, 14-17, 23-26, and 32-35 are rejected under 35 USC § 103(a) as being obvious over Aalbers in view of Pallone.

Under 35 USC § 103(c), subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of 35 USC § 102, shall not preclude patentability under 35 USC § 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Statement of Common Ownership

The present application, application 10/676454, and U.S. Patent 6,865,765 to Aalbers were, at the time the invention of the present application was made, owned by 3M Innovative Properties Company.

In view of the above statement, Applicant has overcome the rejections of the claims under 35 USC 103(a). A Notice of Allowance is respectfully requested.

Respectfully submitted,

06-20-05
Date

By: _____
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